

1 MATTHEW D. POWERS (Bar No. 104795)
matthew.powers@weil.com
2 JARED BOBROW (Bar No. 133712)
jared.bobrow@weil.com
3 SONAL N. MEHTA (Bar No. 222086)
sonal.mehta@weil.com
4 DEREK C. WALTER (Bar. No. 246322)
derek.walter@weil.com
5 NATHAN GREENBLATT (Bar No. 262279)
nathan.greenblatt@weil.com
6 WEIL, GOTSHAL & MANGES LLP
Silicon Valley Office
7 201 Redwood Shores Parkway
Redwood Shores, CA 94065
8 Telephone: (650) 802-3000
Facsimile: (650) 802-3100
9

10 Attorneys for Defendant and Counterclaim Plaintiff
Apple Inc.

11 UNITED STATES DISTRICT COURT
12 NORTHERN DISTRICT OF CALIFORNIA
13 SAN JOSE DIVISION

14 ELAN MICROELECTRONICS
15 CORPORATION,

16 Plaintiff and Counterclaim
Defendant,

17 v.

18 APPLE INC.,

19 Defendant and Counterclaim
20 Plaintiff.

Case No. C-09-01531 RS (PSG)

**APPLE INC.'S NOTICE OF MOTION
AND MOTION TO COMPEL ELAN'S
COMPLIANCE WITH THE PARTIES'
AGREEMENT THAT ELAN
EMPLOYEES WILL BE PRESENTED
FOR DEPOSITION IN THE
NORTHERN DISTRICT OF
CALIFORNIA**

DATE: August 2, 2011
TIME: 10:00 a.m.
JUDGE: Hon. Paul Singh Grewal
CTRM: 5, 4th Floor

**MOTION TO SHORTEN TIME AND
RESET HEARING DATE TO JULY 5,
2011 AT 10:00 AM FILED
CONCURRENTLY HEREWITH**

NOTICE OF MOTION

TO ALL PARTIES AND THEIR ATTORNEYS OF RECORD:

3 PLEASE TAKE NOTICE THAT on August 2, 2011 at 10:00 a.m., or as soon thereafter as
4 counsel may be heard by the above-entitled Court, Defendant and Counterclaim Plaintiff Apple
5 Inc. (“Apple”), will and hereby does respectfully move to compel Plaintiff and Counterclaim
6 Defendant Elan Microelectronics Corporation (“Elan”) to comply with the parties’ agreement that
7 party witnesses will be presented for deposition in the Northern District of California. This
8 motion is based upon the following Memorandum of Points and Authorities, the Declaration of
9 Sonal N. Mehta, and a Proposed Order, each of which are served and filed concurrently herewith,
10 as well as the complete record of this action, evidence and argument that may be presented at a
11 hearing on this motion, and all matters of which the Court may take judicial notice. For the
12 reasons set forth in greater detail in the Memorandum of Points and Authorities and related
13 pleadings submitted herewith, Apple respectfully requests the Court to Order Elan to produce the
14 requested discovery forthwith. A motion to shorten time and reset the hearing on this motion to
15 July 5, 2011, so it can be heard with pending motion relating to the same agreement between the
16 parties, is being filed concurrently herewith.

1.

**THE COURT SHOULD ENFORCE THE PARTIES' AGREEMENT THAT PARTY
WITNESSES WILL APPEAR FOR DEPOSITION IN THE NORTHERN DISTRICT OF
CALIFORNIA**

20 As Apple explained in its May 31, 2011 motion to compel, Elan contends that it is a
21 Taiwanese company with little or no U.S. presence. Although Apple disputes that this prevents
22 Elan from having substantial relevant knowledge regarding the presence of its products in the
23 United States, it does not dispute that Elan's research and business activities and the majority of
24 its employees are located in Taiwan. Accordingly, from the outset of this case, Apple
25 immediately met and conferred with Elan to confirm that it would make its inventors and
26 employees voluntarily available for deposition in this district, where Elan initiated suit. With the
27 exception of specific inventors and employees that Elan was to identify prior to September 18,
28 2009, Elan agreed that it would do so. This agreement was memorialized in the parties

September 2009 Joint Case Management Conference Statement:

The parties agree that named inventors and employees of the parties that do not reside in the United States will be made voluntarily available for deposition in the Northern District of California without service of foreign process except as so identified to the opposing party no later than September 18, 2009.

Dkt. No. 41 at 6. Prior to September 18, 2009, Elan did not identify any individuals that it would be unable to make available for deposition. In advance of the January 2011 CMC, the foregoing agreement was re-memorialized in the Further Case Management Conference Statement. *See* Dkt No. 187 at 3. In that same document, the parties confirmed that neither of them had identified any unavailable witnesses by the September 18, 2009 deadline. *Id.* Thus, Elan has agreed on multiple occasions that it would make its inventors and employees voluntarily available for deposition here in the United States. Despite the foregoing, Elan has refused to make its inventors available for deposition in California, alleging that because the inventors are no longer employees, Elan is powerless to make them available. Apple has already brought a motion to compel on this issue, which is scheduled to be heard on July 5.

Unfortunately, in addition to refusing making its non-employee inventors available for deposition, Elan has also recently refused to make even its *current* employees available for deposition in the Northern District of California, in either their individual or 30(b)(6) capacities. As Elan stated in meet and confer, “it is Elan’s position that Section IV.B of the Joint CMC only applies to Elan’s claims in this action.” *See* Declaration of Sonal Mehta in Support of Apple Inc.’s Motion to Compel Elan’s Compliance with the Parties’ Agreement That Elan Employees Will be Presented for Deposition in the Northern District of California (“Mehta Decl.”), Exh. A [6/13/2011 email correspondence]. In other words, Elan now contends that the parties’ agreement to make witnesses available for deposition in California only applies to witnesses that can provide testimony regarding the patent infringement allegations that Elan is bringing in this Court.

There is no basis for this position. At the outset, there is no language in the parties' agreement to this effect, nor was there any discussion to this effect during the negotiation of the agreement. *See* Mehta Decl. ¶ 2. This is particularly noteworthy because Elan was well aware of Apple's counterclaims—which were filed on July 1, 2009—months in advance of the September

1 30, 2009 CMC statement, where Elan agreed to make its employees available for deposition in
 2 California. *See* Dkt No. 41 (Sept. 30, 2009 CMC statement); Dkt. No 15 (Apple's First Amended
 3 Answer asserting counterclaims filed on July 1, 2009). Thus, if, as Elan contends, it truly
 4 intended for the parties' agreement to apply only to its counterclaims, it surely would have raised
 5 this issue with Apple or requested that the agreement include language to this effect. It did not.
 6 To the contrary, over a year later, after the parties had spent substantial resources litigating
 7 Apple's counterclaims, Elan even reaffirmed the original agreement in the January 20, 2011
 8 further CMC statement, again without any suggestion that it would seek to limit the agreement to
 9 only Elan's claims. It was not until June 10, 2011 that Elan let Apple know for the first time that
 10 it would not present its witnesses in the Northern District of California.¹ Mehta Decl., Exh. A
 11 [6/13/2011 email correspondence] (June 10, 2011 email from J. Bu stating Elan's position that the
 12 parties' agreement only applies to Elan's claims).

13 With respect to 30(b)(6) depositions specifically, Elan contends that "Apple's 30(b)(6)
 14 topics only relate to Apple's counterclaims." *See id.* Elan is wrong again. In fact, Apple's notice
 15 includes topics related to the conception and reduction to practice of the Elan patents-in-suit,
 16 Elan's knowledge of Apple's alleged infringement, marking, and Elan's damages case. All of
 17 these topics relate to Elan's claims, not Apple's. Moreover, even if all of Apple's 30(b)(6) topics
 18 related only to its counterclaims, that still would not provide a basis for abrogating the parties'
 19 agreement regarding deposition location.

20 Finally, it must be noted that Elan initiated this action by suing Apple in this forum. It has
 21 thus chosen to avail itself of the Northern District of California. In these circumstances, even
 22 beyond the parties' express agreement that employees and inventors are to be made available for
 23 deposition in California, Elan simply cannot be heard to complain if it is forced to present
 24

25 ¹ During meet and confer, Elan has taken the position that its employees should be deposed
 26 in Taiwan for efficiency reasons. Briefly, Elan contends that if depositions are conducted in
 27 Taiwan, to the extent one of its witnesses is unprepared with relevant information, it will be able
 28 to quickly identify and present a substitute witness among its employees. However, if Elan
 properly prepares its Rule 30(b)(6) witnesses, there should be no need for it to identify substitute
 witnesses in the first place. Furthermore, with respect to witnesses who testify in their individual
 capacities, this rationale is totally inapplicable.

witnesses here.

II.

CONCLUSION

For the foregoing reasons, Apple's motion to compel should be granted.

Dated: June 28, 2011

By: */s/ Sonal N. Mehta*

Sonal N. Mehta

WEIL, GOTSHAL & MANGES LLP
201 Redwood Shores Parkway
Redwood Shores, CA 94065
Attorneys for Defendant and
Counterclaim Plaintiff Apple Inc.